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09/993,054	11/06/2001	Merrit N. Jacobs	CDS-255	9036

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EXAMINER

GORDON, BRIAN R

ART UNIT PAPER NUMBER

1743

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 09/993,054	Applicant(s) JACOBS ET AL.	
	Examiner Brian R. Gordon	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 April 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 19-23 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 19-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 4-2-07 is/are: a) accepted or b) objected to by the Examiner.
 - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed April 02, 2007 have been fully considered but they are not persuasive. Applicant asserts the prior art reference of Byrd does not teach the use of the pipette to perform mixing as applicant asserts the claimed invention performs or achieves mixing. Specifically applicant states:

"To that end, applicants have amended the claims to recite the claim transitional phrase "consisting essentially of" which excludes materials or steps that materially affect the basic and novel characteristics of the invention. See MPEP 2111.03. Incorporating the mixing cube of Byrd into the claimed invention, would interfere with the mixing mechanism provided by the claimed invention."

Such arguments are directed to intended use and are not commensurate in scope with that of the claims. The claims are directed to an apparatus not a specified process. The manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

While applicant intends for the device to function in a manner to achieve mixing, the mixing affect is not only dependent on the structure, but would also depend on the properties (viscosity) of the liquid and the amount of negative pressure applied thereto. If a slight negative pressure was applied and/or highly viscous fluid is aspirated in applicant's claimed device such mixing as argued would not occur. Furthermore the claim does not specify what is the degree of difference or numerical value in the inequality of the diameters of the cavities and the degree (specific arrangement) of the transitional areas.

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An operator is not limited to using the devices of applicant or the prior art solely as respectively disclosed.

As such, the previous rejection as based upon Byrd is hereby maintained.

Claim Interpretation

1. The examiner notes the rotational motion of aspirated liquid caused by the varying diameters is a rotational motion in the vertical direction (figs. 2A-2C) not horizontally as commonly seen in washing machines, blenders, etc.

Drawings

2. The drawings were received on April 02, 2007. These drawings are acceptable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 20-22 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Byrd US 1,547,562.

Byrd discloses a pipette assembly that comprises a tube (probe) attached to a variously-diametered pipette tip. As seen the figures the device structurally equivalent to that as claimed by applicant. The diameter of the diluting chamber 9 is used for agitation and appears to be at 3 times the diameter of the adjacent chambers.

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As to incorporation of the pump, Byrd discloses the use of a suction tube 3 to which a mouthpiece 4 may be attached and an operator (pump) can provide suction in tube and pipette to draw blood therein in a well known manner (page 1, lines 85-90).

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrd.

Byrd does not disclose the tip portion as a being configured as having the middle cavity being formed of removably mounted elements.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that the tip portion may be manufactured to be assembled in multiple parts. It is conventionally known in the art that pipette tips may be manufactured to be disposable (prevention of cross contamination) as well as multiple pieces allow for ease of cleaning the device and ease of replacing parts rather than the entire device if only a portion is of the device is defective.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrd as applied to claims 19-22 above, and further in view of Zabetakis et al., US 5,773,305 or in the alternative Elkins US 4,119,125.

Byrd does not specify the use of a piston-cylinder pump.

Zabetakis et al. and Elkins both disclose the use of a piston-cylinder pump assemble to aspirate and dispense a fluid such as blood.

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the device of Byrd may be modified to include a piston-cylinder assembly attached to the suction tube to provide the required suction therein.

Conclusion

8. No claims allowed.
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, Telework Thurs., 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Brian R Gordon
Primary Examiner
Art Unit 1743

brg

BRIAN R. GORDON
PRIMARY EXAMINER